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ATTORNEY DOCKET NO. 01173.0014U3 (formerly 25006.0005U3)  
PATENT

GAU 1655

A4  
MLW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of )  
Paul M. Lizardi )  
Serial No.: 09/853,379 ) Group Art Unit: Unassigned  
Filed: May 11, 2001 ) Examiner: Unassigned  
For: **"MOLECULAR CLONING USING  
ROLLING CIRCLE AMPLIFICATION"** )

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

NEEDLE & ROSENBERG, P.C.  
Suite 1200, The Candler Building  
127 Peachtree Street, N.E.  
Atlanta, Georgia 30303-1811

September 27, 2001

Sir:

Submitted herewith is a copy of a form PTO-1449 filed in the parent application (U.S. Serial No. 09/396,281) with the parent application's docket number, serial number, filing date and group art number (if assigned) struck through and those of the present application written in. Each of the references listed on the copy of the form PTO-1449 was submitted to the Examiner and is of record in the parent application. Thus, copies are not provided.

Also enclosed is a new form PTO 1449 listing documents cited by the Examiner in the prosecution of the parent application (Serial No. 09/396,281), and new references A2-A12 not previously cited. Each of the references listed were either submitted or cited by the Examiner and are of record in the priority application, thus copies of these documents are not provided with the exception of newly cited references A2-A12, copies of which are provided.

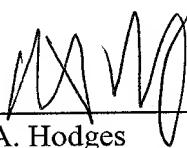
**ATTORNEY DOCKET NO. 01173.0014U3 (formerly 25006.0005U3)  
SERIAL NO.: 09/853,379**

Consideration of the cited documents and making the same of record in the prosecution of the above-noted application are respectfully requested.

It is believed that this paper is being timely filed and that no fee is required for filing thereof. However, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.



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404/688-0770

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date shown below.



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Robert A. Hodges

Date

9/27/01



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 SERIAL NO. 09/853,379  
 Page 1 of 1

Form PTO-1449 U.S. DEPARTMENT OF COMMERCE (Rev. 7-80) PATENT AND TRADEMARK OFFICE  LIST OF PRIOR ART CITED BY APPLICANT (Use several sheets if necessary)		ATTORNEY DOCKET NO.: 01173.0014U3			SERIAL NO. 09/853,379		
		APPLICANT: Paul M. Lizardi					
		FILING DATE: May 11, 2001			GROUP: Unassigned		
		U.S. PATENT DOCUMENTS					
EXAMINER INITIAL		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	A1	6,143,495	11/07/00	Lizardi <i>et al.</i>			
	A2	5,795,714	08/18/98	Cantor <i>et al.</i>			
FOREIGN PATENT DOCUMENTS							
	A3	WO 01/20039	03/22/01	Rothberg <i>et al.</i> (PCT)			
	A4	WO 99/53102	10/21/99	Taylor (PCT)			
	A5	GB 2332516	06/23/99	Sampson <i>et al.</i> (PCT)			
	A6	WO 98/39485	09/11/98	Makarov <i>et al.</i> (PCT)			
	A7	WO 98/14610	04/09/98	O'Neill <i>et al.</i> (PCT)			
	A8	WO 97/43447	11/20/97	Maracas <i>et al.</i> (PCT)			
	A9	WO 97/20948	06/12/97	Koch (PCT)			
OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)							
	A10	Chen <i>et al.</i> "Amplification of Closed Circular DNA <i>In Vitro</i> ," <i>Nucleic Acids Research</i> , 26(4):1126-1127 (February 1998)					
	A11	Lizardi <i>et al.</i> "Mutation Detection and Single-Molecule Counting Using Isothermal Rolling-Circle Amplification," <i>Nature Genetics</i> , 19(3):225-232 (July 1998)					
	A12	Zhang <i>et al.</i> "Amplification of Target-Specific, Ligation-Dependent Circular Probe," <i>Gene</i> , 211:277-285 (1998)					
EXAMINER:			DATE CONSIDERED:				
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Substitute for form 1449A/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)



Sheet 1 of 16

**Complete if Known**

Application Number	09/396,284 091853,319
Filing Date	September 15, 1999 May 11, 2001
First Named Inventor	Paul M. Lizardi
Group Art Unit	1643
Examiner Name	
Attorney Docket Number	YU-124 (OCR-847) 25006.000545U3

**U.S. PATENT DOCUMENTS**

Examiner Initials*	Cite No. <sup>1</sup>	US Patent Document		Name of Patentee or Applicant of Cited Document	Date of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code (if known)			
		4,748,111		Dattagupat, et al.	05-31-1988	
		4,883,750		Whiteley, et al.	12-28-1989	
		4,965,188		Mullis, et al.	10-23-1990	
		4,994,373		Stavrianopoulos, et al.	02-19-1991	
		5,001,050		Blanco, et al.	03-19-1991	
		5,043,272		Hartley	08-27-1991	
		5,130,238		Malek, et al.	07-14-1992	
		5,198,543		Blanco, et al.	03-30-1993	
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		5,328,824		Ward, et al.	07-12-1994	
		5,354,668		Auerbach	10-11-1994	
		5,409,818		Davey, et al.	04-25-1995	
		5,412,087		McGall, et al.	05-02-1995	
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		5,510,270		Fodor, et al.	04-23-1996	
		5,521,065		Whiteley, et al.	05-28-1996	
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		5,591,609		Auerbach	01-07-1997	
		5,614,389		Auerbach	03-25-1997	
		5,614,390		McCaslin, et al.	03-25-1997	
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		5,629,179		Mierendorf, et al.	05-13-1997	
		5,714,320		Kool	02-03-1998	
		5,733,733		Auerbach	03-31-1998	
		5,854,033		Lizardi	12-29-1998	

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Substitute for form 1449A/PTO				Complete if Known	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <small>(use as many sheets as necessary)</small>				Application Number	09/396,281 09/853,374
Sheet	2	of	16	Filing Date	September 15, 1999 May 11, 2001
				First Named Inventor	Paul M. Lizardi
				Group Art Unit	1643
				Examiner Name	
				Attorney Docket Number	YU-124 (OCR 847) 1500L.0005143

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM- DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Office. <sup>2</sup>	Number <sup>2</sup>	Kind Code <sup>3</sup> (if known)		
	JP	4-262799	A		09-18-1992	
	JP	4-304900	A		10-28-1992	
	EP	84173/91	B	Syngene, Inc.	02-18-1992	
	EP	0128 332	A2	Enzo Biochem, Inc.	12-19-1984	
	EP	0356 021	A2	Imperial Chemical Ind. PLC	07-27-1989	
	EP	0439 182	B1	Abbott Laboratories	04-24-1996	
	EP	0466 520	A1	Life Technologies, Inc.	01-15-1992	
	EP	0505 012	A2	F. Hoffmann-La Roche AG	09-23-1992	
	EP	0667 393	A2	Enzo Diagnostics, Inc.	08-16-1995	
	EP	0678 582	A1	Becton Dickinson and Co.	10-25-1995	
	WO	91/80307	A1	Microprobe Corporation	06-13-1991	
	WO	92/01813 A1		Syngene, Inc.	02-06-1992	
	WO	94/24312 A2		Beckman Instruments, Inc.	10-27-1994	
	WO	95/03430 A1		Gen-Probe Incorporated	02-02-1995	
	WO	95/03432 A1		Bio-Rad Laboratories, Inc.	02-02-1995	
	WO	95/22623 A1		Landegren	08-24-1995	
	WO	95/25180 A1		Gen-Probe Inc.	09-21-1995	
	WO	95/35390 A1		Mount Sinai School of Medicine of the City University of New York	12-28-1995	
	WO	96/33207 A1		Glaxo Group Limited	10-24-1996	
	WO	97/19193 A2		Yale University	05-29-1997	
	WO	97/42346 A1		Tepnel Medical Ltd.	11-13-1997	

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Substitute for form 1449A/PTO		Complete if Known	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(use as many sheets as necessary)</i>		Application Number	09/396,281 D91853,379
		Filing Date	September 15, 1999 May 11, 2000
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	1643
		Examiner Name	
3	of	16	Attorney Docket Number YU 124 (OCR 847) 25006.0005113

OTHER ART – NON PATENT LITERATURE DOCUMENTS

Examiner's Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
		ABRAVAYA, et al., "Detection of point mutations with a modified ligase chain reaction (Gap-LCR)," <i>Nucleic Acids Res.</i> 23(4):675-682 (1995).	
		ALIOTTA, et al., "Thermostable Bst DNA polymerase I lacks a 3'->5' proofreading exonuclease activity," <i>Genet Anal.</i> 12(5-6):185-95 (1996).	
		ALVES & CARR, "Dot blot detection of point mutations with adjacently hybridising synthetic oligonucleotide probes," <i>Nucl. Acids. Res.</i> 16:8723 (1988).	
		ARNOLD, et al., "Assay Formats Involving Acridinium-Ester-Labeled DNA Probes," <i>Clin. Chem.</i> 35(8): 1588-1594 (1989).	
		BARANY, "Genetic disease detection and DNA amplification using cloned thermostable ligase," <i>Proc. Natl. Acad Sci. USA</i> 88: 189-193 (1991).	
		BEIER & HOHEISEL, "Versatile derivatisation of solid support media for covalent bonding on DNA-microchips," <i>Nucleic Acids Res.</i> 27(9):1970-7 (1999).	
		BERTINA et al., "Mutation in blood coagulation factor V associated with resistance to activated protein C", <i>Nature</i> 369: 64-67 (1994).	
		BIRKENMEYER & MUSHAWAR, "DNA probe amplification methods," <i>Journal of Virological Methods</i> 35:117-126 (1991).	
		BLANCO & SALAS, "Characterization and purification of a phage $\phi$ 29-encoded DNA polymerase required for the initiation of replication," <i>Proc. Natl. Acad. Sci.</i> 81:5325-5329 (1984).	
		BLANCO, et al., "Highly Efficient DNA Synthesis by the Phage $\phi$ 29 DNA Polymerase," <i>Journal of Biological Chemistry</i> 264(15):8935-8940 (1989).	

Examiner's Signature	Date Considered
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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (use as many sheets as necessary)		Application Number	09/396,284 09/853,379
Sheet	4	of	16
		Attorney Docket Number	YU 124 (OCR 847) 25006.0005113

## OTHER ART – NON PATENT LITERATURE DOCUMENTS

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		BLANCO, et al., "Terminal protein-primed DNA amplification," <i>Proc. Natl. Acad. Sci.</i> 91:12198-202 (1994).	
		BOEHMER & LEHMAN, "Herpes Simplex Virus Type 1 ICP8: Helix-Destabilizing Properties," <i>Journal of Virology</i> 67(2):711-715 (1993).	
		BONALDO, et al., "Normalization and subtraction: two approaches to facilitate gene discovery," <i>Genome Res.</i> 6(9):791-806 (1996).	
		BROUDE, et al., "Enhanced DNA sequencing by hybridization," <i>Proc. Natl. Acad. Sci.</i> 91:3072-76 (1994).	
		BURGESS & JACUTIN, "A new photolabile protecting group for nucleotides," <i>Am. Chem Soc. Abstracts</i> , volume 221, abstract 281 (1996).	
		BUTLER & CHAMBERLIN, "Bacteriophage SP6-specific RNA Polymerase," <i>Journal of Biological Chemistry</i> 257:5772-5778 (1982).	
		CHATTERJEE, et al., "Cloning and overexpression of the gene encoding bacteriophage T5 DNA polymerase," <i>Gene</i> 97:13-19 (1991).	
		CHETVERINA & CHETVERIN, "Cloning of RNA molecules <i>in vitro</i> ," <i>Nucl. Acids. Res.</i> 21:2349-53 (1993).	
		DAUBENDIEK & KOOL, "Generation of catalytic RNAs by rolling transcription of synthetic DNA nanocircles," <i>Nat Biotechnol.</i> 15(3):273-7 (1997).	
		DAUBENDIEK, et al., "Rolling-circle RNA synthesis: Circular oligonucleotides as efficient substrates for T7 RNA polymerase," <i>J. Am. Chem. Soc.</i> 117:7818-19 (1995).	

Examiner's Signature		Date Considered	
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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(use as many sheets as necessary)</i>		Application Number	09/396,281 09/853,379
SEARCHED	INDEXED	Filing Date	September 15, 1999 - May 11, 2001
SEARCHED	INDEXED	First Named Inventor	Paul M. Lizardi
SEARCHED	INDEXED	Group Art Unit	4643
SEARCHED	INDEXED	Examiner Name	
SEARCHED	INDEXED	Attorney Docket Number	YU 124 (OCR 847) 25006.0005143

OTHER ART - NON PATENT LITERATURE DOCUMENTS

Examiner's Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
		DAVANLOO, et al., "Cloning and expression of the gene for bacteriophage T7 RNA polymerase," <i>Proc. Natl. Acad. Sci. USA</i> 81:2035-2039 (1984).	
		DAVIS, et al., <i>Advanced Bacterial Genetics - A Manual for Genetic Engineering</i> (Cold Spring Harbor Laboratory, Cold Spring Harbor, N.Y., 1980)	
		DYNAL, <i>Biomagnetic Techniques in Molecular Biology</i> , 1995.	
		ERNST, et al., "Cyanine dye labeling reagents for sulphydryl groups," <i>Cytometry</i> 10:3-10 (1989).	
		FIRE & XU, "Rolling replication of short DNA circles," <i>Proc. Natl. Acad. Sci. USA</i> 92:4641-4645 (1995).	
		GASPARRO, et al., "Site-specific targeting of psoralen photoadducts with a triple helix-forming oligonucleotide: characterization of psoralen monoadduct and crosslink formation," <i>Nucleic Acids Research</i> 22(14):2845-2852 (1994).	
		GERDES, et al., "Dynamic changes in the higher-level chromatin organization of specific sequences revealed by in situ hybridization to nuclear halos," <i>J. Cell Biol.</i> 126(2):289-304 (1994).	
		GUNJI, et al., "Correlation Between the Serum Level of Hepatitis C Virus RNA and Disease Activities in Acute and Chronic Hepatitis C," <i>Int. J. Cancer</i> 52(5):726-730 (1992).	
		GUO, et al., "Direct fluorescence analysis of genetic polymorphisms by hybridization with oligonucleotide arrays on glass supports," <i>Nucleic Acids Res.</i> 22(24):5456-5465 (1994).	
		GUO, et al., "Enhanced discrimination of single nucleotide polymorphisms by artificial mismatch hybridization," <i>Nature Biotechnology</i> 15:331-335 (1997).	

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Substitute for form 1449A/PTO

Complete if Known

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(use as many sheets as necessary)</i>		Application Number <b>09/396,281</b> <i>09/853,379</i>
OCT 01 2001 U.S. PATENT & TRADEMARK OFFICE		Filing Date <b>September 15, 1999</b> First Named Inventor <b>Paul M. Lizardi</b> Group Art Unit <b>4643</b> Examiner Name
of 16		Attorney Docket Number <b>YU-124 (OCR-847) 25006.0005U3</b>

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		GUPTA, et al., "Expression of HIV-1 RNA in plasma correlates with the development of AIDS: A multicenter AIDS cohort study," <i>Ninth International Conference on AIDS/Fourth STD World Congress</i> June 6-11, 1993, Berlin, Germany.	
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Sheet 7 of 16 Attorney Docket Number YU 124 (OCR 847) 25006.000543

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		HSUIH, et al., "Quantitative Detection of HCV RNA Using Novel Ligation-Dependent Polymerase Chain Reaction", <i>American Association for the Study of Liver Diseases</i> , (Chicago, IL, November 3-7, 1995) [poster abstract].	
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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <small>(use as many sheets as necessary)</small>		Application Number <b>09/396,281</b> <b>09/853,379</b>	
		Filing Date	September 15, 1999 <b>May 11, 2001</b>
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	1643
		Examiner Name	
		Attorney Docket Number	YU 124 (06R-847) 25001.0005U3
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		KAPLAN, et al., "Rapid photolytic release of adenosine 5'-triphosphate from a protected analogue: utilization by the Na:K pump of human red blood cell ghosts" <i>Biochem.</i> 17:1929-1935 (1978).
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		LAMTURE, et al., "Direct detection of nucleic acid hybridization on the surface of a charge coupled device," <i>Nucl. Acids Res.</i> 22:2121-25 (1994).

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OCT 01 2001 U.S. PATENT & TRADEMARK OFFICE JCA-1	of 16	Filing Date First Named Inventor Group Art Unit Examiner Name Attorney Docket Number <i>September 15, 1999 - May 11, 2001</i> <i>Paul M. Lizardi</i> <i>1643</i> <i>YU-124 (OCR-847) 25006.0005013</i>

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		LANDEGREN, "Molecular mechanics of nucleic acid sequence amplification," <i>Trends Genetics</i> 9:199-202 (1993).	
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		LIZARDI, et al., "Mutation detection and single-molecule counting using isothermal rolling-circle amplification," <i>Nat. Genet.</i> 19(3):225-32 (1998).	
		LOCKHART, et al., "Expression monitoring by hybridization to high-density oligonucleotide arrays," <i>Nature Biotechnology</i> 14:1675-1680 (1996).	

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09/396,284-

09/853,379

Filing Date

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First Named Inventor

Paul M. Lizardi

Group Art Unit

1643-

Examiner Name

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Attorney Docket Number

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		LU, et al., "High Concentration of Peripheral Blood Mononuclear Cells Harboring Infectious Virus Correlates with Rapid Progression of Human Immunodeficiency Virus Type 1-Related Diseases," <i>JID</i> 168(5):1165-8116 (1993).	
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09/396,284

09/853,379

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May 11, 2001

First Named Inventor

Paul M. Lizardi

Group Art Unit

1643

Examiner Name

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		MORETTI, et al., "Enhancement of PCR amplification yield and specificity using AmpliTaq Gold DNA polymerase," <i>Biotechniques</i> . 25(4):716-22 (1998).	
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		ØRUM, et al., "Single base pair mutation analysis by PNA directed PCR clamping," <i>Nucleic Acids Research</i> 21(23):5332-5336 (1993).	
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		RIED, et al., "Simultaneous visualization of seven different DNA probes by <i>in situ</i> hybridization using combinatorial fluorescence and digital imaging microscopy," <i>Proc Natl Acad Sci U S A</i> 89(4):1388-92 (1992).	
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<i>OCT 01 2001 U.S. PATENT AND TRADEMARK OFFICE 14 of 16</i>		
Application Number		09/396,281- <i>09/853,379</i>
Filing Date		September 15, 1999 <i>May 11, 2001</i>
First Named Inventor		Paul M. Lizardi
Group Art Unit		1643
Examiner Name		
Attorney Docket Number		YU 124 (OCR 847) 25006 000503

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		SCHWARZ, et al., "Improved yields of long PCR products using gene 32 protein," <i>Nucl. Acid Res.</i> 18:1079 (1989).	
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15

of

16

Application Number

09/396,284

09/853,379

Filing Date

September 15, 1999

May 11, 2001

First Named Inventor

Paul M. Lizardi

Group Art Unit

1643

Examiner Name

Attorney Docket Number

YU 124 (OCR 847) 25016.000545

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		TAYLOR, ed, <u>Protein immobilization: fundamentals and applications</u> (M. Dekker, New York, 1991).	
		TSURUMI, et al., "Functional Interaction between Epstein-Barr Virus DNA Polymerase Catalytic Subunit and Its Accessory Subunit In Vitro," <i>Journal of Virology</i> 67(12):7648-7653 (1993).	
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		WANSINK, et al., "Fluorescent Labeling of Nascent RNA Reveals Transcription by RNA Polymerase II in Domains Scattered Throughout the Nucleus," <i>Journal of Cell Biology</i> 122(2): 283-293 (1993).	
		WELFORD, et al., "Detection of differentially expressed genes in primary tumor tissues using representational differences analysis coupled to microarray hybridization," <i>Nucleic Acids Res.</i> 26(12):3059-65 (1998).	

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Sheet 1 of 16	of 16	Filing Date	September 15, 1999 May 11, 2001
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	1643
		Examiner Name	
		Attorney Docket Number	YU 124 (OCR 847) 25006.0005U3

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		WIEDMANN, et al., "Ligase Chain Reaction (LCR) - Overview and Applications," <i>PCR Methods and Applications</i> (Cold Spring Harbor Laboratory Press, Cold Spring Harbor Laboratory, NY, 1994) pages S51-S64.	
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		ZHU & ITO, "Purification and characterization of PRD1 DNA polymerase," <i>Biochimica Biophysica Acta</i> 1219(2): 267-276 (1994).	
		ZIJDERVELD & VAN DER VLIET, "Helix-Destabilizing Properties of the Adenovirus DNA-Binding Protein," <i>Journal of Virology</i> 68(2):1158-1164 (1994).	

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		Filing Date	September 16, 1999 <i>May 11, 2001</i>
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	1643
		Examiner Name	
Sheet	1	of	2
		Attorney Docket Number YU-124 (GCR-847) 25001, 000519	

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		Filing Date	September 15, 1999
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	1643
		Examiner Name	
		Attorney Docket Number	YU-124-(OCR-847)-250 (L. MANTUS)
Sheet 1 of 2	of	2	

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